



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,592	06/08/2000	David S. Jones	252312007300	1002
25226	7590	12/10/2004	EXAMINER	
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			LUKTON, DAVID	
			ART UNIT	PAPER NUMBER

1653

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/590,592

Applicant(s)

JONES ET AL.

Examiner

David Lukton

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/16/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38,46,54-57,66-71,82-87,89-93,108-110,119,124,126-128 and 131-174 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims:

Claims pending in the application are 38,46,54-57,66-71,82-87,89-93,108-110,119,124,126-128 and 131-174.

Pursuant to the directives of the amendment filed 9/16/04, claims 163-174 have been added, and the following claims amended: 38, 66, 67, 82, 83, 91, 92, 108-110, 133, 134, 138, 139, 141-146. Claims 38, 46, 54-57, 66-71, 82-87, 89-93, 108-110, 119, 124, 126-128, 131-174 are now pending.

Applicants' arguments filed 9/16/04 have been considered and found persuasive in part.

The following abbreviations are used hereinbelow:

“**BAM**” represents a biologically active molecule

“**VPM**” represents a valency platform molecule



Claims 38, 46, 54-57, 66-71, 82-87, 89-93, 108-110, 119, 124, 126-128, 131-174 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 82 recites that “n is about 200 to about 500”. However, this renders the claim indefinite as to the upper and lower limits of the range.
- Claim 89 recites that a conjugate according to claim 46 can be prepared by covalently bonding BAM's to a VPM. If the VPM is that of claim 38, it is not difficult to see how the conjugate is to be prepared. But if the VPM is entirely different from that of claim 38, it is not at all clear as to how one would endeavor to prepare the conjugate. The same issue applies in the case of claim 131. In response, applicants have argued that by virtue of the claim dependence, applicants have imported the subject matter of claim 46 into claim 89. However, claim 89 recites the following:

“a method.. comprising covalently bonding... to a VPM”

That is, claim 89 recites “a VPM”, meaning any VPM. There are two possibilities for claim 89:

(a) one takes the (unprotected) compound recited in claim 38 and bonds BAM's thereto, or

(b) one takes a compound other than that recited in claim 38 and bonds BAM's thereto

Which of the preceding is intended? If the first of these two is intended, it is suggested that the structural formula that is recited in claim 38 be recited in claim 89.

- Claim 108 makes reference to linker moieties. However, these are not suggested by claim 46, upon which claim 108 depends. Accordingly, the claim dependence is not proper. One option would be to amend claim 46 to recite the optional presence of linker moieties. The same issue applies to several other claims, for example, in the case of claim 141 versus claim 67, in the case of claim 144 versus claim 83, in the case of claim 87 versus claim 83, and in the case of claim 57 versus claim 46.
- Claim 170 recites the phrase “between about 1.05 to 1.2”. However, this renders the claim indefinite as to the upper and lower limits of the polydispersity. The same issue applies in the case of claim 171.
- Claim 148 recites the phrase “less than about”, thus rendering the claim indefinite as to the upper limit of polydispersity. See also claim 150.
- Claim 168 recites that the amino groups are unprotected, and “ONH₂” is present adjacent thereto in parentheses. However, the group “ONH₂” is not amino *per se*, but rather aminooxy. Accordingly, there is a contradiction.




Serial No. 09/590,592
Art Unit 1653

-4-

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber, can be reached at 571-272-0925. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.


**DAVID LUKTON
PATENT EXAMINER
GROUP 1653**